

22. (Amended) (-)-Cis-4-amino-1-(2-hydroxymethyl-1,3-oxathiolan-5-yl)-(1H)-pyrimidin-2-one or a pharmaceutically acceptable salt, ester, or salt of such ester thereof, or any other compound which, upon administration to a recipient, is capable of providing (-)-cis-4-amino-1-(2-hydroxymethyl-1,3-oxathiolan-5-yl)-(1H)-pyrimidin-2-one [or an antivirally active metabolite or residue thereof].

REMARKS

Applicants would like to thank the Examiner for meeting with their attorneys on June 24, 1994 to discuss the May 23, 1994 Final Office Action. In that interview, the Examiner agreed that the above amendments would overcome the rejection under 35 U.S.C. § 112, second paragraph. Accordingly, applicants request that the Examiner withdraw the rejection.

The Examiner has maintained the rejections under 35 U.S.C. § 102 and 103 over United States patent 5,204,466 ("the '466 patent). Specifically, the Examiner contends that "it is a [sic] routine for one to test all possible stereoisomers of an active compound". The Examiner also contends that "US '466 also teaches how to prepare BCH-189 or BCH-189 analogs that are enantiomerically enriched". Applicants traverse.

The Examiner's rejection should be withdrawn for two main reasons. First, the Examiner is using the improper standard of patentability. It is well-established that "obvious to experiment" is not a proper standard for obviousness.

"The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success viewed in the light of the prior art . . . Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.